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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,840	03/07/2002	William Gabriel Pagan	RSW920010228US1	9436

50594 7590 03/08/2007		EXAMINER
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950 PENINSULA CORPORATE CIRCLE	ART UNIT / PAPER NUMBER
SUITE 3020	
BOCA RATON, FL 33487	2173

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	03/08/2007	PAPER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/092,840
Filing Date: March 07, 2002
Appellant(s): PAGAN, WILLIAM GABRIEL

Scott D. Paul
Reg. No. 42,984
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1 January 2007 appealing from the Office action

mailed 5 June 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,491,795   Beaudet et al.   2-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4, and 7 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Performing a pre-defined window manipulation operation, separate from a focus change operation, upon an inactive document window, which is critical to the practice of the invention, is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Amended claims 1, 4, and 7 include the limitation, "performing a pre-defined window manipulation operation, separate from a focus change operation, upon an inactive document window". The factual evidence found in applicant's specification does not support such a negative limitation. While applicant has disclosed many types of window manipulation operations, the specification fails to disclose an embodiment of the invention wherein a focus change operation is separate from other pre-defined window operations, as now required by the claims. As a result, all claims dependent on claims 1, 4, and 7 are similarly rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's

admitted prior art and Beaudet et al (US Patent 5,491,795), hereinafter Beaudet.

Regarding claims 1 and 7, in Applicant's Fig. 1 and on pages 2-3 of the disclosed

specification, Applicant allows for a pull-down menu in an activated open document window with

a listing of open document windows and corresponding interactive user interface elements

(taught as the ability to select a window through the pull-down menu using point-and-click

methods), and responsive to the activation of one of the interactive user interface elements,

performing a pre-defined window manipulation operation upon an inactive open document

window corresponding to the selected interactive user interface element (taught as the change

of focus from the active window to the selected inactive window). Inherently, the software of the

admitted prior art is stored and accessed through machine-readable storage.

However, Applicant's admitted prior art fails to explicitly teach performing a pre-defined

window manipulation operation, separate from a focus change operation, upon an inactive open

document window.

Beaudet teaches a window management system wherein a window list is presented to

the user and through the manipulation of an interactive element allows for window management

operations such as moving, sizing, restoring and closing of windows represented in the window

list without changing the focus of the window. See Beaudet, col. 7, lines 17-49.

Therefore, it would have been obvious to one of ordinary skill in the art, having the

teachings of the admitted prior art and Beaudet before him at the time the invention was made

to modify the pre-defined window manipulation through pull-down menus of the admitted prior

art with the interactive window list control system of Beaudet, in order to obtain a pull-down

menu listing windows capable of being operated upon through manipulation of an interactive element in the menu.

One would be motivated to make such a combination due to the fact that the pull-down menu presents a list of windows to the user, as does the window control management system of Beaudet. One would further be motivated to make such a combination for the advantage of the increased functionality provided by Beaudet over the simple focus change allotted by Applicant's admitted prior art. See Beaudet, col. 2, lines 1-9.

Regarding claims 2 and 8, the admitted prior art teaches generating a window manipulation event in response to the activation of an interactive user interface element (the change of focus after the selection of a window from the pull-down menu). Inherently, the window manipulation event is processed in a message handling routine associated with the activated open document window, and identifies the inactive open document window corresponding to the interactive user interface element, posts a window manipulation event to the identified inactive open document window, and processes the posted window manipulation event in a message handling routine associated with the inactive open document window, allowing for the focus control change from the active window to the selected inactive window. Inherently, the software of the admitted prior art is stored and accessed through machine-readable storage.

Regarding claims 3 and 9, the admitted prior art has been shown to teach a pre-defined window manipulation operation for an inactive window selectable through a pull-down menu.

However, the admitted prior art fails to explicitly teach performing a window close operation, print window operation, and a file save operation through the pull-down window.

While Beaudet does not explicitly teach the use of a print window or file save operation through the disclosed window management system, such operations are well-known window and file operations and would be obvious to include in the window management of Beaudet, such as in the right-click menu of Microsoft Internet Explorer, that allows the user to print or save a displayed file. The Examiner takes OFFICIAL NOTICE of these teachings.

Regarding claim 4, the admitted prior art teaches a pull-down menu disposed in an active open document window, a list of open document windows disposed in the pull-down menu, and a set of activatable interactive user elements disposed in the pull-down menu corresponding to one of the listed open document windows (see Applicant's Fig. 1).

However, the admitted prior art fails to explicitly teach including a set of interactive user elements corresponding to listed open document windows, positioned adjacent to a corresponding open document window, and an event handler configured to post pre-defined window manipulation events to inactive open document windows associated with activated ones of the activatable interactive user elements, and wherein the pre-defined window manipulation events are separate from a focus change operation.

Beaudet teaches a window management system wherein a window list is presented to the user and through the manipulation of an interactive element allows for window management operations such as moving, sizing, restoring and closing of windows represented in the window list without changing the focus of the window. See Beaudet, col. 7, lines 17-49. As can be seen in Figs. 1, 2, and 4, Beaudet also teaches positioning an interactive element adjacent to the listed name of an open document window. Beaudet further teaches an event handler configured to post pre-defined window manipulation events to inactive open document windows associated with activated ones of the activatable interactive user elements, taught as the ability

to perform window management operations such as moving, sizing, restoring and closing of windows represented in the window list without changing the focus of the window. See Beaudet, col. 7, lines 17-49.

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of the admitted prior art and Beaudet before him at the time the invention was made to modify the pre-defined window manipulation through pull-down menus of the admitted prior art with the interactive window list control system of Beaudet, in order to obtain a pull-down menu listing windows capable of being operated upon through manipulation of an interactive element in the menu.

One would be motivated to make such a combination due to the fact that the pull-down menu presents a list of windows to the user, as does the window control management system of Beaudet. One would further be motivated to make such a combination for the advantage of the increased functionality provided by Beaudet over the simple focus change allotted by Applicant's admitted prior art. See Beaudet, col. 2, lines 1-9.

Regarding claim 5, Beaudet has been shown *supra* to teach activatable interactive user elements that a user may manipulate to perform a variety of window functions. However, Beaudet fails to explicitly teach these interactive user elements being buttons. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use a button as the interactive element of Beaudet, for the simple reason that the interactive user elements of Beaudet function in a manner almost exactly similar to applicant's claimed button. See Beaudet, col. 4, lines 46-55, wherein the interactive user element (icon) is manipulated by a single user mouse-click, much like the selection of a generic interface button, as claimed.

Therefore, it would have been obvious to one of ordinary skill in the art to modify

Beaudet to obtain the invention as specified in claim 5.

Regarding claim 6, Beaudet has been shown *supra* to teach a close window event

associated with an interactive element of the disclosed window management system (see col. 7,

lines 45-49).

Regarding claim 10, in Applicant's Fig. 1 and on pages 2-3 of the disclosed specification,

Applicant allows for a pull-down menu in an activated open document window with a listing of

open document windows and corresponding interactive user interface elements (taught as the

ability to select a window through the pull-down menu using point-and-click methods), and

responsive to the activation of one of the interactive user interface elements, performing a pre-

defined window manipulation operation upon an inactive open document window corresponding

to the selected interactive user interface element (taught as the change of focus from the active

window to the selected inactive window). Inherently, operations performed on windows are

operating system services, and thus the admitted prior art teaches performing pre-defined

operating system services manipulations.

Beaudet teaches a window management system wherein a window list is presented to

the user and through the manipulation of an interactive element allows for window management

operations such as moving, sizing, restoring and closing of windows represented in the window

list without changing the focus of the window. See Beaudet, col. 7, lines 17-49. As can be seen

in Figs. 1, 2, and 4, Beaudet also teaches positioning an interactive element adjacent to the

listed name of an open document window.

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of the admitted prior art and Beaudet before him at the time the invention was made to modify the pre-defined window manipulation through pull-down menus of the admitted prior art with the interactive window list control system of Beaudet, in order to obtain a pull-down menu listing windows capable of being operated upon through manipulation of an interactive element in the menu.

One would be motivated to make such a combination due to the fact that the pull-down menu presents a list of windows to the user, as does the window control management system of Beaudet. One would further be motivated to make such a combination for the advantage of the increased functionality provided by Beaudet over the simple focus change allotted by Applicant's admitted prior art. See Beaudet, col. 2, lines 1-9.

Regarding claim 11, the admitted prior art teaches generating a window manipulation event in response to the activation of an interactive user interface element (the change of focus after the selection of a window from the pull-down menu). Inherently, the window manipulation event is processed in a message handling routine associated with the activated open document window, and identifies the inactive open document window corresponding to the interactive user interface element, and posts a window manipulation event to the identified inactive open document window, allowing for the focus control change from the active window to the selected inactive window. Inherently, operations performed on windows are operating system services, and thus the admitted prior art teaches performing pre-defined operating system services manipulations.

Regarding claims 12-14, Beaudet teaches interactive user interface elements being positioned separately from the listing of open document windows, as can be seen in Figs. 1, 2, and 4.

(10) Response to Argument

In response to Appellant's argument of pages 3 and 4 of the Brief, concerning the rejection of claims 1, 4 and 7 under 35 USC 112, 1st paragraph, the examiner respectfully disagrees. Appellant has argued that page 7, lines 8-11 of Appellant's disclosure provides support for the negative limitation, "performing a pre-defined window manipulation operation, separate from a focus change operation, upon an inactive document window". The alleged support of the disclosure states, "a selected open document window in the pull-down menu list can be manipulated through another open document without requiring activation of the selected open document window". The examiner contends that this sentence merely discloses that a pull-down menu list in an active window may be used to manipulate an inactive window, and does not specifically exclude the cited window focus operation. No support in the specification exists excluding a focus change from the set of window manipulation operations, and the examiner contends that a focus change is indeed a window manipulation operation.

Generally, the above-cited portion discloses that a pull-down menu in an active window may be used to manipulate an inactive window. Many window manipulation operations exist, including but not limited to saving, closing and printing a window, as claimed. The examiner contends that a focus change is indeed a window manipulation operation. Therefore, as the pull-down menu cited in Appellant's disclosure may be used to change the focus, instead of some other well-known means of focus change (for example, the alt-tab function or selection of

a window tab in the taskbar as is found in Microsoft Windows operating systems), the pull-down

menu as cited allows the manipulation of inactive windows.

In response to Appellant's arguments of pages 5-7, that there is no sufficient motivation

to combine the teachings of the admitted prior art and the Beaudet reference, the examiner

respectfully disagrees. The examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where

there is some teaching, suggestion, or motivation to do so found either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re*

Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21

USPQ2d 1941 (Fed. Cir. 1992). In this case, a functionality similarity exists between the

admitted prior art and the window control management system of Beaudet, in that both are

capable of carrying out window manipulation operations on inactive windows. Furthermore,

although the manipulation system of the admitted prior art is in a pull-down menu, and the

manipulation system of Beaudet is found in a separate window, it can be seen that both are a

similar list of windows. Beaudet at col. 2, lines 1-9 states the importance of providing a

convenient means for performing operations on a window. Therefore, one would have been

motivated to include the window manipulation operations of Beaudet into the pull-down window

manipulation menu of the admitted prior art, as the aforementioned pull-down menu is located

neatly within the active window and is thus readily available to the user through simple interface

manipulation.

Appellant's arguments of pages 7-11 are similar to arguments stated above (the relevant

teachings of the admitted prior art, the obviousness and subsequent result of a combination

between the admitted prior art and the Beaudet reference), and those deemed redundant will

not be repeated for the sake of brevity. The examiner maintains that the motivation provided in the rejection of the claims, the response to arguments above, and the resulting combination of the admitted prior art and Beaudet would be sufficient to produce the invention as claimed.

In response to Appellant's arguments of pages 11-13, the examiner respectfully disagrees. Appellant has argued on page 12 that "the fact that Beaudet did not recognize this so-called 'obviousness modification' is evidence that the claimed invention was not obvious to one having ordinary skill in the art", and on page 13 that, "if, as asserted by Appellant, that Beaudet was aware of the teachings of the Admitted Prior Art, then the fact that Beaudet did not arrive at the claimed invention is also indicia of nonobviousness". The examiner contends that Appellant's logic in this assertion is flawed. The examiner reiterates the prior statement that "because a modification is obvious does not necessitate that it must be done". For example, a car may come in various colors, with various interiors and amenities. This does not mean that a buyer must purchase a single car that has every color, with every interior and every amenity because he can. Similarly, there are a plurality of menu types to be found in state-of-the-art graphical user interfaces, such as the pull-down menu of the admitted prior art, the iconic array of Beaudet, graphical toolbars, three-dimensional displays, pop-up menus, etc. Therefore, the examiner contends that because Beaudet does not teach his menu interface as a pull-down menu, graphical toolbar, three-dimensional display, pop-up menu, or any other type of menu system available to one of ordinary skill in the art, does not mean that it cannot bet done. Subsequently, as shown above, the examiner believes that ample motivation exists to include the functionality of the menu system of Beaudet into the pull-down menu system of the admitted prior art.
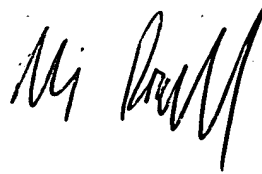
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related

Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Roswell

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